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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,839	02/15/2002	Tetsuo Maoka	382.1036	1537

7590 07/19/2005

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EXAMINER

FOLEY, SHANON A

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/076,839

Applicant(s)

MAOKA ET AL.

Examiner

Shanon Foley

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1,2 and 8-12 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

The Group and/or Art Unit of your application has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1648, Examiner Foley.

Applicant's election without traverse of Group I in the response filed June 23, 2005 is acknowledged. However, upon consideration of the amended and newly presented claims, a new restriction of the claims is required.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 and 2, drawn to a nucleotide sequence encoding SEQ ID NO: 1 or the complement thereof, classified in class 536, subclass 23.1.
- II. Claim 8, drawn to a nucleotide sequence encoding NIa-Pro (SEQ ID NOs: 3 and 4), classified in class 536, subclass 23.72.
- III. Claims 9 and 10, drawn to a nucleotide sequence encoding the P1 protein (nucleotides 136-1575 of SEQ ID NO: 1), classified in class 536, subclass 23.72.
- IV. Claims 11 and 12, drawn to a nucleotide sequence of the capsid coding region (nucleotides 9064-9945 of SEQ ID NO: 1), classified in class 536, subclass 23.72.
- V. Claims 11 and 12, drawn to a nucleotide sequence of the HC-Pro coding region (nucleotides 1576-2946 of SEQ ID NO: 1), classified in class 536, subclass 23.72.
- VI. Claims 11 and 12, drawn to a nucleotide sequence of NIb (nucleotides 7501-9063 of SEQ ID NO: 1), classified in class 536, subclass 23.72.

The inventions are distinct, each from the other because of the following reasons:

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Inventions I-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Group I is drawn to a nucleotide sequence encoding SEQ ID NO: 1, which corresponds to the full-length genomic nucleotide sequence of the Papaya Leaf-Distortion Mosaic Virus. This sequence is patentably distinct from groups II-VI because it can generate virus particles. Groups II-VI are drawn to different portions of group I. None of the products of groups II-VI can generate virus particles. Each of these groups are patentably distinct from each other and group I because each sequence has a unique sequence structure. Due to the structural uniqueness of each sequence, each encodes a different protein. Therefore, each of the nucleotide sequences of Groups I-VI has a different function because they encode different products, i.e. the PLDMV virus genome, NIa-Pro, P1, capsid, HC-Pro and NIb, respectively.

These inventions are distinct for the reasons given above. Due to the structural and functional divergence of each nucleotide claimed in each group, the search required for Groups I-VI is separate and non-overlapping as evidenced by their separately designated SEQ ID NO even though they are classified in the same class/subclass. Moreover, a search for all of the groups would be burdensome to the Office since each SEQ ID NO. must be searched independently of all others in the patent and non-patent literature databases world-wide, which uses the time and resources of the Office as there are only two sequence processors for the entire technology center. This sequence search does not preclude a worldwide patent search as well as cross-referencing indexes and a non-patent literature search for relevant terms. Therefore, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanon Foley whose telephone number is (571) 272-0898. The examiner can normally be reached on M-F 6:00 AM - 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (571) 272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Shanon Foley  
Primary Examiner  
Art Unit 1648